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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,617	09/19/2003	Vipul J. Shah	03-28 US	4025
23693	7590	10/07/2005	EXAMINER CHOI, LING SIU	
Varian Inc. Legal Department 3120 Hansen Way D-102 Palo Alto, CA 94304			ART UNIT 1713	PAPER NUMBER

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/664,617

Applicant(s)

SHAH, VIPUL J.

Examiner

Ling-Siu Choi

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 and 39-46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 01/20/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-46 are now pending.

#### ***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16, drawn to a halogenated polymer of vinyl aromatic monomers, classified in class 526, subclass 296.
  - II. Claims 17-30, drawn to a polymer bead (fluorocarbyl), classified in class 526, subclass 242.
  - III. Claims **31-38**, drawn to a method to separate a mixture of analytes, classified in class 210, subclass 635.
  - IV. Claims 39-46, drawn to a chromatographic method for separating labeled nucleic acids from unlabeled nuclei acids, classified in class 435, subclass 803.
3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different

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process of using that product (MPEP ' 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product in solid phase extraction.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP ' 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product in solid phase extraction.

Inventions III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP ' 806.04, MPEP ' 808.01). In the instant case the different inventions relate to a method to separate a mixture of analytes and a chromatographic method to separate labeled nucleic acids from unlabeled nuclei acids

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Ms Bella Fishman on November 15, 2004, a provisional election was made with traverse to prosecute the invention of Group III, claims 31-38. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-30 and 39-46 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

3. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

**A person shall be entitled to a patent unless --**

**(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

8. Claims 31-38 are rejected under 35 U.S.C. 102(b) as being anticipated by Gjerde et al. (US 6,355,791 B1).

A method of separating a mixture of analytes, comprising	
1	applying the mixture of analytes to a chromatography sorbent comprising polymer beads of aromatic vinyl monomers substituted with hydrocarbyl or haloarbyl substituents, or combinations thereof, comprising from 1 to 1,000,000 carbon atom wherein the aromatic vinyl monomers or the hydrocarbyl substituents or both have been functionalized by <b>halogenation</b> ; and
2	removing polar analytes from the chromatography sorbent by a hydrophilic solvent wash

(summary of claim 31)

Gjerde et al. disclose a method to separate a mixture of double stranded polynucleotide fragments having up to 1500 base pairs, the method comprising (a) applying the mixture to a polymeric separation medium having non-polar surfaces, wherein the surfaces are characterized by being substantially free from multivalent cations which are free to bind with DNA, wherein the surfaces are the surfaces of the interstitial spaces of a polymeric monolith and (b) separating the mixture of polynucleotides, wherein **the polymeric monolith includes poly(styrene-divinylbenzene)** which is **brominated** to move the remaining double bonds on the surface thereof (Example 7; claims 1 and 9). Thus, the present claims are anticipated by the disclosure of Gjerde et al.


### **Conclusion**

9. Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on 571-272-1114.



**LING-SUI CHOI**  
**PRIMARY EXAMINER**

September 28, 2005